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10/067,141	02/04/2002	Joyce B. Palazzotto	50142US010	7314

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EXAMINER
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LEWIS, AARON J

ART UNIT	PAPER NUMBER
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3743

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/067,141  
Filing Date: February 04, 2002  
Appellant(s): PALAZZOTTO ET AL.

MAILED

JUL 04 2005

Group 3700

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Kevin W. Raasch  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/02/2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-20 include language which is not supported by the specification as originally filed. That language includes the terminology "...said spacer further having a microphone extending therefrom; ..."; and "...a microphone extending therefrom and into a clean air envelope of said face mask..." .

Figures 5 and 6 of the instant application illustrate microphone 74 situated WITHIN the confines of the so called spacer 50. Neither drawing figures 5 and 6 nor the instant specification disclose a microphone extending THEREFROM. The microphone being situated within the confines of the spacer as disclosed and illustrated by the instant application differs from the arrangement in Birli et al. ('693) patent which illustrates microphone 20 extending THEREFROM (the spacer element 18) (fig.2) and which illustrates microphone 20 extending THEREFROM AND INTO AN INTERIOR OF THE FACE MASK (fig.3).

### ***Interference***

Claims 1-20 of this application have been copied from U.S. Patent No. 5,463,693 for the purpose of an interference. These claims are not patentable to the applicant for the following reasons:

An interference cannot be initiated since a prerequisite for interference under 37CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Claims 7 and 16 recite that the spacer is constructed of a "plastic material" whereas claim 7 of patent ('693) recites "...a thermoplastic material...". One of ordinary skill would recognize thermoplastic materials to refer to synthetic resins that may be softened by heat, and then regain their original properties upon cooling whereas not all plastic materials exhibit this property.

Each of claims 19 and 20 recites "...a clean air envelope..." (in line 8 and 7 respectively) whereas each of claims 19 and 20 of patent ('693) recites "...an interior

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space...". The term "clean air envelope" is not an equivalent substitute for the term "...interior space..." as used in patent ('693). The "clean air envelope" in the instant application defines the combination of space within the face mask and space within spacer 50 whereas "interior space" (of the face mask) in patent ('693) defines space within the face mask 14 exclusive of the space within spacer 18. Applicant's attention is invited to lines 2,3 and 9, 10 of claim 19 in patent ('693) which initially defines a face mask having an inhalation port through which a wearer of the mask inhales ambient air and subsequently defines a microphone extending therefrom (spacer 18) and into an interior space of said face mask. The claimed interior space of said face mask is physically different from the combination of space within the face mask and the space within spacer 50 of the instant application. Consequently, theses terms "clean air envelope" and "interior space" are not interchangeable equivalent elements.

Claims 1-20 of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. 5,463,693.

The examiner does not consider this claim to be directed to the same invention as that of U.S. Patent No. 5,463,693 because of the differences between the claims submitted as copied and the actual claims 1-20 of patent ('693) as pointed out above. Accordingly, an interference cannot be initiated based upon this claim.

Further, it is submitted that claims 1-20 of patent ('693) do not define the same subject matter as is set forth in the disclosure of the instant application. Claims 1-20 of patent ('693) include at least one major difference with the disclosure of the instant application. In claims 1 and 10 of patent ('693) the recitation "...said spacer further

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having a microphone extending therefrom..." and in claims 19 and 20, the recitation "...a microphone extending therefrom and into an interior of said face mask...", each defines a microphone which extends FROM a spacer and a microphone which extends from a spacer and INTO an interior of the face mask. The element recited in the claims of the instant application which may be readable upon the microphone of patent ('693) is "speech reception means...". The "...speech reception means..." as defined in the claims of the instant application is neither recited to extend from a spacer nor extend from a spacer and into the interior of a face mask. Even if the phrase "...extending therefrom..." might be interpreted as defining a microphone which extends in any direction to any extent from a spacer, a reading of the claim language in light of the specification and drawings of patent ('693) reveals that the microphone has only on intended orientation which is within the interior of the face mask.

### **(11) Response to Argument**

Appellant's assertion that the instant specification discloses a speech transmission adaptor/spacer (50) having a microphone (74) extending therefrom within the broadest reasonable interpretation of claims 1-18 is disagreed with because the microphone (74) does not extend "therefrom" the spacer (50); it is situated within the actual boundaries of the spacer as illustrated in figs. 5 and 6 of the instant application. Further, a standard dictionary definition of the word "therefrom" reveals its definition as: "From that, this, or it; coming from that time, location or thing.". Microphone (74) of the instant application as illustrated in figs. 5 and 6 does not come (i.e. extend) from spacer (50), it is clearly situated within spacer (50). On page 11, lines 7-9, the language "As depicted in Fig. 5,

the microphone 74 extends from the peripheral housing 70 of the spacer of speech transmission adaptor 50, but not into the interior space of the face mask.” was not part of the specification as originally filed. This language was added by amendment filed 12/10/99 and as such is evidence that the specification as originally filed does not support a microphone extending “therefrom” the spacer.

Appellant’s assertion that claims 19 and 20 find support in the instant specification based at least on a definition of a clean air envelope at page 4, lines 19-21 is disagreed with because that portion of the instant specification defines a clean air envelope as existing between the body of the face mask and the face of a wearer as does page 2, lines 28-29. Further, the microphone (74) does not extend “therefrom” spacer (50), it is situated within spacer (50). Since the spacer (50) is not disclosed as forming a portion of a clean air envelope and the clean air envelope is disclosed (page 2, lines 28-29 and page 4, lines 19-21) as being bounded by the mask and a wearer’s face, the microphone (74) must extend “therefrom” spacer (50) and into a clean air envelope of the face mask in order to provide support for claims 19 and 20. A review of the instant specification and drawing figures 5 and 6 reveals that microphone (74) remains within spacer (50) rather than extending therefrom and into the confines of a clean air envelope. Thus, the instant specification does not provide support for claims 19 and 20.

Appellant’s arguments for declaration of interference between the instant application and patent (‘693) to Birli et al. are disagreed with for the reasons set forth on pages 4-6 of the Office action dated 07/02/2003. A review of patent (‘693) reveals an interior space to be that space between a wearer’s face and the interior of the face mask (figs.2 and 3)

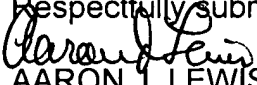


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with the microphone (20) extending "therefrom" spacer (18) into that interior space. This configuration is clearly different from that illustrated by appellant's instant specification figs.5 and 6 and there is no support in appellant's instant specification for such a configuration. Thus, there is no reason to declare an interference.

Finally, in an effort to decide whether the instant specification contains subject matter described in such a way as to reasonably convey to one skilled in the art that the instant inventor(s), at the time the instant application was filed, had possession of the claimed invention, one would seek an analogous art meaning for the terminology "...extending therefrom..." by reviewing respiratory art including Birli et al.. One of ordinary skill upon reviewing Birli et al. would find that for a first object (e.g. a microphone) to extend therefrom a second object (e.g. a spacer), that first object must extend beyond the physical boundaries of the second object thereby establishing an art related meaning of the terminology "extending therefrom". Accordingly, one of ordinary skill would not find that appellant's instant specification, as originally filed, provides a basis for claims 1-20 specifically because the microphone (74) of the instant application does not "extend therefrom" (i.e. extend beyond the boundaries of) the spacer (50).

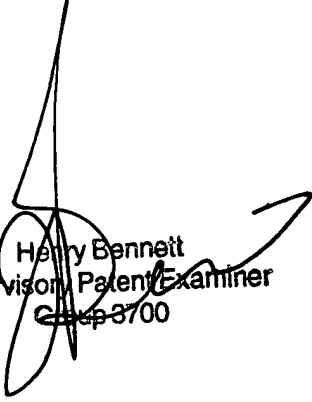
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,  
  
AARON J. LEWIS  
Primary Examiner  
Art Unit 3743

Aaron J. Lewis  
May 31, 2005

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